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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,712	07/08/2003	Dale Pestes	CDM:3912.9999	9438
7590 12/09/2005			EXAMINER	
Chernoff Vilhauer McClung & Stenzel, L.L.P.			APANIUS, MICHAEL	
1600 ODS Tower			ART UNIT	
601 SW Second Avenue			PAPER NUMBER	
Portland, OR 97204-3157			3736	

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/615,712	<b>Applicant(s)</b> PESTES ET AL.	
	<b>Examiner</b> Michael Apanius	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because the reference numerals are "hand-drawn". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informality: at page 2, line 22, "would" should be --wound--. Appropriate correction is required.

3. The use of the trademark DACRON (page 2, last paragraph) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

4. Claim 5 is objected to because of the following informality: at line 2 of the claim, "send" should be --said--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 4 and 5 contain the trademark/trade name DACRON. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to

identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe synthetic fiber material and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Gradone (US 3,712,296).

10. In regards to claim 1, Gradone discloses a swab (figure 1) for collecting a specimen and depositing the specimen into a collection device comprising: (a) an elongate handle (18); (b) a swab tip (12) which is releasably attached to said handle, at a first end thereof; and (c) a sleeve (14) which slidably fits on said handle and is moveable such that it can be urged toward said first end of said handle to displace said swab tip off of said handle. Note that the swab tip is attached to the handle via the sleeve. Furthermore, note that when the sleeve is displaced towards the left in figure 2, the swab tip and the sleeve are displaced off of the handle together.

11. In regards to claim 2, the handle and the sleeve are circular in cross-section.

12. In regards to claim 3, the swab tip is an absorbent fabric material (column 1, lines 62-65).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gradone (US 3,712,296) in view of Nason (US 4,707,450).

15. Gradone discloses that the swab tip is made of cotton (column 1, lines 62-65) instead of DACRON.

16. Nason teaches using DACRON or cotton that is secured to a handle only by friction created by winding said strip onto the handle while the strip is in tension (column 4, lines 6-10) as alternative swab tips.

17. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used a DACRON material secured by winding as taught by Nason in the swab of Gradone because it is an art-recognized equivalent of a cotton swab tip that functions as an absorbent material.

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gradone (US 3,712,296).

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19. Gradone discloses a method of collecting a specimen with a swab and depositing a specimen into a collection device comprising: (a) providing a swab (figure 1) having a swab tip which is releasably attached to one end of an elongate handle (18); (b) providing a sleeve (14) which is slidable along said handle; (c) collecting a specimen on said swab tip (column 2, lines 33-35); (d) placing said swab such that said swab tip is adjacent to an opening in a collection device (column 2, lines 36-39).

20. Although Gradone discloses displacing the swab tip into a collection device by pushing the handle (column 2, lines 36-43), a step of urging the sleeve to displace the swab tip from the handle is not expressly disclosed.

21. However, to one of ordinary skill using the device, it would have been readily apparent that displacement of the swab tip from the handle could alternatively be achieved through urging the sleeve forward to displace the swab tip into a collection device.

22. It would have been obvious to one having ordinary skill in the art at the time of invention to have used the alternative step of urging the sleeve forward in the method of Gradone because it is apparent that urging the sleeve forward would displace the swab tip into a collection device.

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2,668,974 discloses a disposable swab for toilet bowls. US 3,954,563 discloses an apparatus for detection of neisseria gonorrhoeae in females.

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US 4,283,809 discloses a swab holding tool. US 4,803,998 discloses a swab retaining vial cap and method of use. US 5,910,122 discloses a saliva collector with an aspirating pipette.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8:30am-5pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA

  
CHARLES MARTIN  
PRIMARY EXAMINER